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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,879	01/17/2001	Naohito Takae	1341.1077 (JDH)	4985
21171 7590 08/24/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LEE, JUSTIN YE	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/760,879	Applicant(s) TAKAE ET AL.	
	Examiner Justin Y. Lee	Art Unit 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,7,9,11,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed "triggering **simultaneous** update" is not disclosed in the specification or drawing.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbe et al. (US Patent Number 6,278,885) in view of Rignell et al. (US Patent Application publication number 2001/0053688 A1) and further in view of Johansson et al. (US 5,418,837).

Regarding claim 1, Hubbe et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (3) from an external device (1, 2, 5) via a wireless communication link (Figure 1), said portable terminal having a main body provided with a built-in memory (second memory- column 5, line 1), and an attachable/detachable storage medium (first memory, e.g. SIM card - column 4, line 65), the method comprising:

accepting a request by said external device related to a change of setting in said portable terminal via the wireless communication link (column 3, lines 27-32);  
and

sending a single setting changing message (short radio message; SMS - abstract; column 3, lines 35-40; column 5, lines 4-9), from said external device to said portable terminal, in response to the accepted request (column 3, lines 27-32),  
and

wherein the setting changing message includes a computer program determined to be suitable for the portable terminal ("commands to be acted on" - column 4, line 3; "updating commands" - column 3, lines 27-32) that triggers changes to contents of the built-in memory together with contents of the storage medium of the portable terminal at a time (column 5, lines 2-3), and a setting changing identifier (header 6 - Figure 2) that identifies the setting changing message such that said portable terminal is configured to execute a different function (an update by definition implies a change or different function as claimed; see "adding soft-ware" - column 4, line 47) (column 2, lines 26-34).

Art Unit: 2617

- In spite of that someone makes the request (which includes a settings change for the portable terminal; Hubbe et al.'s "updating commands"), Hubbe et al. does not specify it is the user of the portable terminal who makes the request. Nevertheless, the manner of operating a device does not differentiate apparatus claim from the prior art (see MPEP 2114) and sending a single setting changing mail related to data identified in said request from the user.

On the other hand, this feature is conventional in the art as shown by Rignell et al. In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 - Figure 2) wherein the user of the portable terminal makes the request as claimed (see in particular paragraph 0029) and sending a single setting changing mail related to data identified in said request from the user (paragraph 77-83 and 90-91, the support message is generated according to the support request triggered by the mobile user).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable the user of the portable terminal to make the request instead of or in addition to someone else, first, because the manner of operating a device does not differentiate apparatus claim from the prior art (MPEP 2114), and, second, because users would be capable of performing the changes/updates when necessary, possible, and/or advantageous (e.g. when they have time).

- Even though Hubbe et al. discloses that the setting changing message is, for example, SMS (short message service) message (abstract; column 3, lines 35-40; column 5, lines 4-9), Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by applicant.

In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 - Figure 2) where either one of SMS or e-mail or any other suitable format can be used to send update/support information/commands enabling the mobile unit to perform an update of the settings in a memory of the mobile unit (see in particular paragraph 0107; see also paragraphs 0037 and 0084). SMS and e-mail are interchangeable as suggested by Rignell et al. Some advantages of e-mail are that it is low cost, and widely available.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are interchangeable as suggested by Rignell et al., and, second, because e-mail is low cost, and widely available.

Hubbe et al. and Rignell et al. do not disclose causes said portable terminal to determine to which memory the computer program should be stored and the setting changing mail is sent based on the authentication of the user as a subscriber.

Johnasson et al. further disclose causes said portable terminal to determine to which memory the computer program should be stored (col. 2, lines 42-57, the mobile telephone is caused to store a computer program in to the memory 15 of the

mobile telephone) and the setting changing mail is sent based on the authentication of the user as a subscriber (col. 1, lines 30-33 the SIM card must be authenticated before the mobile phone can work).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Johansson et al. into the teachings of Hubbe et al. and Rignell et al. for the purposes of more efficient way to upgrading mobile telephone).

In general, claims 11-12 are obvious variations of claim 1; therefore, they rejected for the same reasons shown above. For example:

As to claims 11 and 12, they are the corresponding system and recording medium claims of method claim 1; therefore, they are rejected for the same reasons applied above for claim 1.

4. Claims 5, 7, 9, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbe et al. (US Patent Number 6,278,885) in view of Rignell et al. (US Patent Application publication number 2001/0053688 A1) and Lentz (US 4,975,950) and further in view of Johansson et al. (US 5,418,837).

Regarding claim 5, Hubbe et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (3) from an external device (1, 2, 5) via a wireless communication link (Figure 1), said portable terminal having a main body provided with a built-in memory (second memory- column 5, line 1), and an

attachable/detachable storage medium (first memory, e.g. SIM card - column 4, line 65), the method comprising:

receiving a single setting changing message (short radio message; SMS - abstract; column 3, lines 35-40; column 5, lines 4-9) sent from said external device in said portable terminal, via the wireless communication link (column 3, lines 27-32), the setting changing message including a computer program determined to be suitable for the portable terminal ("commands to be acted on" - column 4, line 3; "updating commands" - column 3, lines 27-32) that triggers changes to contents of both the built-in memory and the storage medium of the portable terminal at a time (column 5, lines 2-3), and a setting changing identifier (header 6 - Figure 2) that identifies the setting changing mail;

identifying the setting changing message based on the setting changing identifier (header 6 - Figure 2); and

Updating the contents of both of said built-in memory and said storage medium collectively (e.g. "both") based on content of the received setting changing mail such that said portable terminal is configured to execute a different function (an update by definition implies a change or different function as claimed; see "adding software" - column 4, line 47),

storing the computer program in said built-in memory (col. 5, lines 2-3 and col. 3, lines 65-col. 4, lines 4).

- Even though Hubbe et al. discloses that the setting changing message is, for example, SMS (short message service) message (abstract; column 3, lines 35-40;

column 5, lines 4-9), Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by applicant.

In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 - Figure 2) where either one of SMS or e-mail or any other suitable format can be used to send update/support information/commands enabling the mobile unit to perform an update of the settings in a memory of the mobile unit (see in particular paragraph 0107; see also paragraphs 0037 and 0084). SMS and e-mail are interchangeable as suggested by Rignell et al. Some advantages of e-mail are that it is low cost, and widely available. Rignell et al. further discloses a setting changing identifier (software version number) that identifies the setting changing mail; and identifying the setting changing message based on the setting changing identifier (paragraph 0044, 0077, 0091, etc) and sending a single setting changing mail related to data identified in said request from the user (paragraph 77-83 and 90-91, the support message is generated according to the support request triggered by the mobile user).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are interchangeable as suggested by Rignell et al., and, second, because e-mail is low cost, and widely available.

Hubbe et al. and Rignell et al. together do not disclose when said storage medium is replaced with another storage medium updating contents of said other

storage medium by running the computer program contained in the setting changing mail stored in said built-in memory.

Lentz further disclose when said storage medium is replaced with another storage medium updating contents of said other storage medium by running the computer program contained in the setting changing mail stored in said built-in memory (col. 1, lines 21-34, the virus copies itself on to a storage device each time a storage device is connected with a infested computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Lentz into the teachings of Hubbe et al. and Rignell et al. for the purposes of coping a specific program onto a storage device automatically (col. 1, lines 21-34).

Hubbe et al. and Rignell et al. and Lentz do not disclose storing the received computer program in said built-in memory if the setting changing identifier specifying to effect a set-up change each time a subscriber identity module card is reinserted into the portable terminal and the setting changing mail is sent based on the authentication of the user as a subscriber.

Johansson et al. further disclose storing the received computer program in said built-in memory if the setting changing identifier specifying to effect a set-up change each time a subscriber identity module card is reinserted into the portable terminal (col. 2, lines 42-57, computer program is stored in a built-in memory 15 of mobile telephone when a software upgrading module card is inserted into the mobile telephone).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Johansson et al. into the teachings of Hubbe et al. and Rignell et al. and Lentz for the purposes of more efficient way to upgrading mobile telephone) and the setting changing mail is sent based on the authentication of the user as a subscriber (col. 1, lines 30-33 the SIM card must be authenticated before the mobile phone can work)..

Regarding claim 7, Hubbe et al. and Rignell et al. and Lentz and Johansson et al. disclose everything claimed as applied above (see claim 5). In addition, the combination teaches wherein said storage medium comprises an IC card or a subscriber identity module card (e.g. SIM card - column 3, lines 4-5; column 4, line 65) issued by a communication provider (column 3, lines 23-25), each provided with a processor (processing means; microprocessor- column 3, lines 7-10) (17 -Figure 3) and a memory (column 3, lines 7-10) (18 - Figure 3) so that in the collectively updating of the contents, said main body has a processor (11 - Figure 3) that updates the contents of said built-in memory (12 - Figure 3) by executing the computer program contained in said setting changing mail ("commands to be acted on" - column 4, line 3; "updating commands" - column 3, lines 27-32), and said IC card or subscriber identity module card is updated by a processor-to- processor communication between the processor in said main body and the processor in said IC card or in said subscriber identity module card (e.g. SIM card) (column 3, lines 11-15; and citations above of Hubbe et al.).

Regarding claim 9, Hubbe et al. and Rignell et al. and Lentz and Johansson et al. disclose everything claimed as applied above (see claim 5). In addition, the combination teaches if setting changing identifier specifying to effect the same set-up change to the ME each time the subscriber identity module card is reinserted into a new ME, said storing stores the received computer program in said storage medium (column 5, lines 2-3); and when said storage medium is inserted into a main body of another portable terminal, updating contents in a built-in memory of said mail body of the other portable terminal by running the computer program contained in the setting changing mail stored in said storage medium (single card can be used in multiple phones or vice versa - column 4, lines 8-14; card memory contents are compared against built-in memory, e.g. buffer, to determine update need - column 4, lines 51-55; and citations above of Hubbe et al.).

As to claim 13, it is a corresponding system claim of method claim 5; therefore, it is rejected for the same reasons applied above for claim 5.

Regarding claim 21, Hubbe et al. and Rignell et al. and Lentz and Johansson et al. disclose everything claimed as applied above (see claims 5 and 13). In addition, the combination teaches said storing unit storing the received setting changing mail in said storage medium (Hubbe et al. col. 3, lines 65-col. 4, lines 4 and Lentz, col. 1, lines 21-34); and

When said storage medium is inserted into a main body of an other portable terminal, updating contents in a built-in memory of said main body of the other portable terminal by running the computer program contained in the setting changing

mail stored in said storage medium (Hubbe et al. col. 4, lines 8-14, a card is capable of being used in other mobile phones and Lentz, col. 1, lines 21-34, that the virus on the storage device and pass onto other computers when the storage device is connected to the other computers).

As to claim 13, it is a corresponding system claim of method claim 5; therefore, it is rejected for the same reasons applied above for claim 5.

Regarding claim 21, Hubbe et al. and Rignell et al. and Lentz and Johansson et al. disclose everything claimed as applied above (see claims 5 and 13). In addition, the combination teaches said storing unit storing the received setting changing mail in said storage medium (Hubbe et al. col. 3, lines 65-col. 4, lines 4 and Lentz, col. 1, lines 21-34); and

When said storage medium is inserted into a main body of an other portable terminal, updating contents in a built-in memory of said main body of the other portable terminal by running the computer program contained in the setting changing mail stored in said storage medium (Hubbe et al. col. 4, lines 8-14, a card is capable of being used in other mobile phones and Lentz, col. 1, lines 21-34, that the virus on the storage device and pass onto other computers when the storage device is connected to the other computers).

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbe et al. (US Patent Number 6,278,885) in view of Rignell et al. (US Patent Application publication number 2001/0053688 A1) and Lentz (US 4,975,950).

Hubbe et al. disclose storing a setting message received from an external device in a built-in memory of the portable telephone connected to a telephone network (short radio message; SMS - abstract; column 3, lines 35-40; column 5, lines 4-9 and column 3, lines 27-32 and Fig. 1), said setting message having a program determined to be suitable for said portable telephone triggering update to contents of the built-in memory and a storage medium of the portable telephone ("commands to be acted on" - column 4, line 3; "updating commands" - column 3, lines 27-32 and column 5, lines 2-3, the setting message is received by mobile phone 3 and immediately update the content of the built-in memory and then update the storage medium of SIM);

- Even though Hubbe et al. discloses that the setting changing message is, for example, SMS (short message service) message (abstract; column 3, lines 35-40; column 5, lines 4-9), Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by applicant and sending a single setting changing mail related to data identified in said request from the user.

In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 - Figure 2) where either one of SMS or e-mail or any other suitable format can be used to send update/support information/commands enabling the mobile unit to perform an update of the settings in a memory of the mobile unit (see in particular paragraph 0107; see also paragraphs 0037 and 0084). SMS and e-mail are interchangeable as suggested by Rignell et al. Some advantages of e-mail are that it is low cost, and widely available. Rignell et al. further discloses a setting changing identifier (software

version number) that identifies the setting changing mail; and identifying the setting changing message based on the setting changing identifier (paragraph 0044, 0077, 0091, etc) and sending a single setting changing mail related to data identified in said request from the user (paragraph 77-83 and 90-91, the support message is generated according to the support request triggered by the mobile user).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are interchangeable as suggested by Rignell et al., and, second, because e-mail is low cost, and widely available.

Hubbe et al. and Rignell et al. together do not disclose updating contents a new storage medium provided to the portable terminal via the program without requiring a comparison of contents stored in the built-in memory with contents of the new storage medium.

Lentz further disclose updating contents a new storage medium provided to the portable terminal via the program without requiring a comparison of contents stored in the built-in memory with contents of the new storage medium (col. 1, lines 21-34, the virus copies itself on to a storage device each time a storage device is connected with a infested computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Lentz into the teachings of Hubbe et al. and Rignell et al. for the purposes of coping a specific program onto a storage device automatically (col. 1, lines 21-34).

***Response to Arguments***

6. Applicant's arguments filed on 12/13/2006 have been fully considered but they are not persuasive.


Regarding the Hubbe, Rignell, Johansson, and Lentz references, applicant states that, the combination do not teach the setting changing mail is related to data identified in said request from the user and authentication of the user as a subscriber.	In contrast to applicant's assertions, Rignell reference teaches the support message is generated according to a support request triggered by the mobile user (paragraph 77-83 and 90-91). And Johansson reference teaches the SIM card need to be authenticated to make sure the owner is the authorized user of the SIM card before the mobile phone or SIM card can work (col.1 ,lines 30-33).
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Y. Lee whose telephone number is (571) 272-5258. The examiner can normally be reached on M - F 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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